UNITED STATES PATENT AND TRADEMARK OFFICE

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TUCKER ELLIS & WEST LLP
1150 HUNTINGTON BUILDING
925 EUCLID AVENUE
CLEVELAND, OH 44115-1414

EXAMINER
NGUYEN, THUY-VI THI

ART UNIT	PAPER NUMBER
3689	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
Office Action Summary	10/816,653	SINGH ET AL.
	Examiner	Art Unit	
	THUY-VI NGUYEN	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 May 2009</u>.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3-9,11-16, 23 and 25-28</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1,3-9,11-16,23 and 25-28</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This is in response to the applicant's communication filed on May 07, 2009,

wherein:

Claims 1, 3-8, 9, 11-16, 23, 25-28 are currently pending;

Claims 1, 3, 5, 9, 23, have been amended;

Claims 2, 10, 17-22, 24 have been cancelled.

As on 05/07/09, Independent claims 1, 9 and 23 are amended as followed:

A system/method/computer implement method for providing selective fee-based

sharing of access to data stored on a shared data peripheral device comprising the

steps of:

1) a data peripheral system comprising at least one data input/out device

including a scanner;

2) secure data storage medium on a server in network communication with the

input/output device;

3) means/step for allocating a storage area in a secure data storage medium on

a server;

4) means/step for receiving login data corresponding to an identity of an

associated user

5) means/step for receiving, from the associated user, formatting data

corresponding to a format for storage of electronic document data;

6) means/step for communicating, via a data network, electronic document data recieved from the associated user via ~~at least one data input/output device~~ a scanner in a data peripheral system and in network communication with the storage medium, into the storage area of the secure data storage medium for storage in accordance with received formatting data such that no copy of the electronic document data is stored on a non-volatile memory of the data input/output device;

7) accounting means adapted/step for securing charge information from the associated user, which charge information allows for securing of payment for use the data peripheral system

8) verification means adapted/step for securing charge verification information corresponding to charge in formation received from the associated user

9) means adapted/step for enabling operation of the data peripheral system in accordance with an output of the verification means so as to provide fee-based access of the associated user to the peripheral system

10) means adapted/step for receiving, from the associated user, an access control list corresponding to an identity of at least one user and an e-mail address corresponding thereto selected by the associated user as authorized to have future access to the electronic document data stored in storage area of the secure data storage medium;

11) communicating the access control list to the server;

12) means adapted/step for storing the access control list in the server associatively with the electronic document data, which access control list dictates an

identity of users authorized to access the data stored in the storage area of the secure

data storage medium;

14) means adapted/step for generating secure login data for each authorized

user associated with the access control list

15) means adapted/step for communicating, via e-mail, login information

corresponding to secure login data to each authorized user;

14) means adapted /step for receiving login data from the at least one authorized

user via a browser in data communication with the server;

15) means adapted/step for authenticating received login data from the at least

one authorized user; and

16) means adapted/step for communicating the electronic document data stored

in the storage area of the secure data storage medium to the at least one authorized

user in accordance with an output of the authenticating step/means.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-8, 9, 11-16, 23, 25-28 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention.

Claim 9, recited the terms " communicating, via a data network, electronic

document data received from the associated user a scanner in a data......" is unclear.

Therefore, it is interpreted as ....the associated user via a scanner.

Claim 9 and 23, recites the phrase " the data input/out put device", there is

insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1, 4-8, 9, 12-16, 23, 25-28 are rejected under 35 U.S.C. 103(a) as being

unpatentable over SHERIDAN (US 5,760,917) in view of JACKSON ET AL (US

6,760,128)

As for independent claims 1, 9 and 23 SHERIDAN discloses a

system/method/computer implement method for providing a sharing of access to data

stored on a shared data peripheral device comprising the steps of:

1) a data peripheral system comprising at least one data input/out device

including a scanner;

{see at least figures 3-4 and 6}

2) secure data storage medium on a server in network communication with the

input/output device;

{see at least figures 1, 3-4, and 6 e.g. "*Hub station 201 or central image server

and storage 20*", see at least col. 4, lines 34-67; col. 8, lines 40-67}

3) means/step for allocating a storage area in a secure data storage medium on

a server/central hub;

{see at least figures 1, 3-4 see at least col. 4, lines 34-67; col. 8, lines 40-67

discloses the distributing or providing the storage means for the user upload and store

the image data on the network/*central hub station 20*}

4) means/step for receiving login data corresponding to an identity of an

associated user

{see at least figures 2 and 6, col. 4, lines 48-67, col. 10, 38-41 and lines 61-67;

discloses the user *logs on/access or communication with the hub station or server*; or

user registration process at hub station 20}

5) means/step for receiving, from the associated user, formatting data

corresponding to a format for storage of electronic document data;

{see at least figures 1- 4, col. 8, lines 58-67; col. 9, lines 31-67; disclose the

receiving different format data/image from the user e.g. "*type of processing and

hardcopy images*'" and *image set signal in a suitable format* e.g. GIF, PICT};

6) means/step for communicating, via a data network, electronic document

data/image data received from the associated user via a scanner in a data peripheral

system and in network communication with the storage medium,

{see at least figures 3-4 and 6; col. 8, lines 1-15; col. 9, lines 30-57 discloses the

digital image data/document data from the scanner system 6 at processor scanner

station to the central storage by a communication network; col. 11, lines 50-56 discloses

the transmitting of digital image from processor scanner station to hub station 20}.

<u>Note</u>: as for the term " such that no copy of the electronic document data is

retained…..input/output device". SHERIDAN discloses processor scanner to scan the

hardcopy image/document to obtain a corresponding digital image and then storing or

loading these digital images on the central storage area {see figures 3-4, col. 10, lines

55-60; col. 11, lines 50-55; col. 13, lines 20-30}. This indicates that the information/data

is not stored or retained on the input/output device.

9) enabling operation of the data peripheral system/scanning service

{see figures 3-4 discloses the operating of hardcopy image is scanned using

processor scanner and then is uploaded into the central server}. Note: as for the term

"to provide fee-based access...system", this is not a positively recited steps in a method

claim, but rather than intended use of the step/function "enabling".

10) means adapted/step for receiving, from the associated user, an access

control list corresponding to an identity of at least one user and an e-mail address

corresponding thereto selected by the associated user as authorized to have future

access to the electronic document data stored in storage area of the secure data

storage medium;

{see at least figure 2, col. 4, lines 48-67; col. 5, lines 1-18; discloses the access

control list or list of users who have the access rights into the file of the user, for

example: the user select the image signal set or sets to be share with others, and the

identity of those others (e.g. nick names or email address) which indicates the access

rights that the user can grant to the designated third parties (other users).

11) communicating the access control list to the server;

{see at least figure 1-2; col. 4, lines 48-67; col. 5, lines 1-32 discloses the

selected access right set are transmitted to hub station "201"/server, each of the access

right of the third parties are stored at hub station 20/server in association with the

corresponding third party's electronic address (email address)}

       12) means adapted/step for storing the access control list in the server

associatively with the electronic document data/electronic image data, which access

control list dictates an identity of users authorized to access the data stored in the

storage area of the secure data storage medium;

       {see at least figure 1-2; col. 4, lines 48-67; col. 5, lines 1-42 discloses list of users

who have the access rights or each of the access right of the third parties are stored at

hub station 20/server in association with the corresponding third party's electronic

address (email address)};

       14) means adapted/step for generating secure login data for each authorized

user associated with the access control list;

       {see at least col. 5, lines 46-67; col. 6, lines 1-24, discloses the third parties

(authorized users) contact hub station 201/server with the associated access code in

order to get access into the shared files/image data which are created from the user};

       15) means adapted/step for communicating, via e-mail, login information

corresponding to secure login data to each authorized user;

       {see col. 5, lines 19-42 discloses the Hub Station 201/server is programmed so

as to automatically transmit a message to each third party's electronic address. This

message will include an electronic address for the hub station (such as URL designation

for a WWW site) by which each third party can connect to hub station 201, a listing of

the access rights of the granted access right set which the user has granted to that third

party/authorized user, the access identification (such as third party's email address), the

message an identification of the user/or an identification of the digital image set to which

the third party has been granted access;

and also col. 5, lines 46-67 discloses each of the third parties would receive the

email message and may then connect to hub station 201};

14) means adapted /step for receiving login data from the at least one authorized

user via a browser in data communication with the server;

{see figures 1-3; col. 3, lines 5-7; col. 5, lines 47-67; col. 6, lines 1-24 discloses

after the third parties/authorized users receive the email message from the hub station

201, the third party at the terminal transmit to hub station 201, the access identification

indicated in the previously received e-mail message from hub station 201, along with a

request to access the image set in accordance with one of the granted access rights; if

the access identification is incorrect, the third party/authorized user will be refused

access in accordance with the request to access from it. If all are correct, the third party

will be granted the requested access};

15) means adapted/step for authenticating received login data from the at least

one authorized user

{see col. 5, lines 46-64 inherently discloses the authenticating or confirming the

logging process, for example: when the third party/authorized user get access into the

hub station 201and provide the access identification information to view the shared

image data, if the access identification is incorrect, the third party/authorized user will be

refused access in accordance with the request to access from it. If all are correct, the third party will be granted the requested access}; and

16) means adapted/step for communicating the electronic document data stored in the storage area of the secure data storage medium to the at least one authorized user in accordance with an output of the authenticating step/means

{see col. 3, lines 5-15; col. 5, lines 46-67; discloses the server/hub station 201 allow the third party to view the shared the images files after the third party is granted the requested access to the hub station}.

SHERIDAN discloses the claimed invention as indicated above. **SHERIDAN** further discloses the scanning service for the user to scan the hard copy image/data at the locations that are convenience to the user. However, **SHERIDAN** does not discloses the features in steps (7) charge information from the associated user, which charge information allows for securing of payment for use the data peripheral system; (step 8) verification means adapted/step for securing charge verification information corresponding to charge in formation received from the associated user.

In the similar method of uploading or storing the file document or image into the network server or central storage in order to share with other parties using the internet, **JACKSON ET AL** discloses (7) charging information from the use for the use of the uploading the information/image data on the server/service provider {see figure 8B col. 1, lines 24-27; col. 14, lines 6-13 "*pay a monthly fee for storage*", "*user is also billed monthly for storing the user's data/information/images*"}; (8) verification information

corresponding to charge information received from the user {see col. 4, lines 42-53

"*verify the payment identifier*"}.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to provide the teachings of **SHERIDAN** to include charging the user for storing

the information/data/image in the storage area on the server as taught by **JACKSON**

ET AL for the benefit of <u>obtaining a profit</u> for the service provider when providing a

service "paying a fee for storing the user's images". {see col. 14, lines 6-13}.

As for claims 4 and 12, which deal with the peripheral system includes at least

one of a printer, facsimile, scanning device, character recognition system, and storage

device, this is fairly taught in SHERIDAN [...figures 1-4].

As for claims 5 and 13, which deal with means/step for selecting parameters for

a selected data processing operation undertaken in connection with the data stored in

the secure data storage medium, this is fairly taught in SHERIDAN [...see figure 2, col.

4, lines 47-67; col. 5, lines 1-17];

As for claims 6, 14 and 26, which deal with charge information includes

information associated with at least one of a pre-paid debit card, coupon, and credit

card, this is fairly taught in JACKSON ET AL [...*debit card or credit card*; col. 4, lines 42-

53].

As for claims 7, 15 and 27, which deal with the feature of tracking the user's

usage of the data peripheral system and generating a cost for the user's usage of the

data peripheral system, this is fairly taught in JACKSON ET AL {see figure 8B; col. 14,

lines 9-13}].

As for claims 8, 16 and 28, which deal with the feature of applying the

generated cost to the user's charge information, this is fairly taught in JACKSON ET AL

{see figure 8B; col. 14, lines 9-13.

5.   Claims 3, 11, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over

SHERIDAN in view of **JACKSON ET AL** and further in view of **AOYAGI** (US

2003/0071900).

As for claims 3, 11, 25, HAMADA/ BURTON ET AL discloses the claim

invention as stated above <u>except for</u> means adapted/step for selectively de-allocating

the storage area in the secure data storage medium after expiration of a pre-selected

duration.

AOYAGI discloses means adapted for selectively de-allocating the selected

storage area in the secure data storage medium after expiration of a pre selected

duration [...i.e. the image data to be deleted/de-allocated based on the order of the

image data retention dates; par. 0055; abstract and figure 7].

Therefore, It would have been obvious in one of ordinary skill in the art at the

time of the invention to incorporate the allocating the image data in a storage medium of

SHERIDAN / JACKSON ET AL to include the method of de-allocating the image data

as taught by AOYAGI in order to reduced the storage capacity medium as well as

reducing the customer usage's charge.

Response to Arguments

6.   Applicant's arguments file on 05/07/09 with respect to amended claims 1, 9 and

23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./
Examiner, Art Unit 3689

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689